

Page 5

10/667,537 Heck 4-1/LUC-424

Remarks

Reconsideration of the application is requested. Claims 7, 9, 10 and 12-14 are pending.

IDS Correction:

With regard to the previously submitted information disclosure statement, the prior art document listed as "2003/040300" should be corrected to read: 2003/0040300. Since this typographical error was noted by the examiner, it is believed that the subject document has been made a record and already considered by the examiner.

Claim Rejections - 35 U.S.C. §103

Independent claim 7 was rejected in the Office Action under 35 U.S.C. 103 as being obvious based on Berger et al. (U.S. Publication No. 2003/0152203) in view of Muhonen (WO 99/66746). Applicants respectfully submit that the applied references, with or without modification or combination, assuming, *arguendo*, that the modification or combination of the applied references is proper, does not teach or suggest one or more elements of the claimed invention, as further discussed below.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." Emphasis added.

The method of claim 7 is directed to delivering at least a portion of a multimedia message to a **non-MMS enabled handset**. A multimedia message containing a voice portion is received and

stored at a message server in a mailbox assigned to a recipient of the multimedia message. A determination is made if the recipient uses a handset that can receive a short message service, SMS, message. If the recipient utilizes an SMS enabled handset, an SMS notification message is generated and transmitted to the recipient's handset. The notification message communicates to the recipient that a voice message is awaiting delivery. **Upon receipt of an independent, conventional voice channel cellular call from the recipient at the message server**, the voice portion of the information is transmitted to the recipient utilizing a voice channel communication mode supported by the conventional voice channel cellular handset of the recipient. It will be noted that the recipient retrieves the stored voice message over a conventional voice channel using the conventional cellular handset of the recipient.

In the Office Action Berger was said to teach a method for delivering at least a portion of a multimedia message originated by a multimedia messaging service, MMS, enabled handset to a non-MMS enabled handset. However, it is clear from the teachings of Berger that the user is assumed to utilize an Internet-enabled phone having a web browser; see paragraphs 29 and 37. Thus, Berger assumes that the recipient has an MMS enabled handset or its equivalent. Berger describes in paragraph 30 that the mobile home supports hyperlink recognition of phone numbers. The process of using the system of FIG. 2 of Berger "begins with the user starting a web browser on his mobile phone and using (80) a Universal resource locator (URL) to establish a communication with the messaging server"; see paragraph 38. As explained in paragraph 50, messaging information displayed to the user is sent to the browser of the mobile device as hypertext markup language where each option, i.e. message, has a related URL. A receiving mobile phone without such a capability would be unable in accordance with the teachings of Berger to select specific messages and transmit the identification of the message to be retrieved to the UM server. Therefore, Berger teaches away from the requirement of the present invention according to claim 7 in that Berger requires the message receiving mobile phone to have a browser or otherwise be hypertext enabled, i.e. the receiving mobile phone is MMS enabled.

Paragraph 35 of Berger was alleged to support the requirement of transmitting information contained in a multimedia message to the recipient utilizing a communication mode supported by a non-MMS enabled handset of the recipient. As explained above, it would be clear to a person

of ordinary skill the art from a reading of Berger that an MMS enabled handset or its equivalent is required in order to initiate and control the transmission of a message from the UM server to a handset. It is mentioned in paragraph 35 that in some implementations a text-to-speech subsystem will be used to deliver textual e-mail messages "to a person listening on a traditional phone over a POTS line". However, this suggestion is consistent with the teachings of Berger as explained above. That is, an MMS enabled handset or computing device is first required to transmit the identification of a message to the UM server causing the server to transmit the identified message to a different receiving device such as a separate POTS telephone. Such an arrangement is known in Universal messaging systems wherein a user employs a personal computer to transmit a web based message to the Universal messaging server causing the server to transmit a stored voice message to a separate POTS telephone of the user. The reference in paragraph 35 of Berger is consistent with this type of operation and is consistent with the remainder of the teachings of Berger. Importantly, there is no teaching in Berger of how (other than explained in this paragraph) that a common POTS line phone could interact with the UM server since it is stated that the UM server requires web based/URL commands. Hence the operation in Berger does not teach "upon receipt of an **independent, conventional voice channel cellular call** from the recipient ... seeking access to the multimedia message awaiting delivery" as per claim 7.

With regard to the rejection of claim 7, Muhonen is relied upon for teachings related the steps of storing the message in a mailbox assigned to a recipient, and determining if the recipient utilizes an MMS enabled handset. Muhonen is not relied upon with regard to the step of claim 7 of "upon receipt of an independent, conventional voice channel cellular call from the recipient ... seeking access to the multimedia message awaiting delivery". It is apparent from FIG. 6 and related text of Muhonen that the transmission of the stored information to the recipient is made by one or more serially transmitted packets of digital data. That is, Muhonen does not teach or suggest the ability to transmit a stored voice message over a conventional cellular voice channel as conventional spoken information to the cellular handset of the recipient. Hence, neither Berger nor Muhonen, nor the combination thereof, provide a teaching of "upon receipt of an independent, conventional voice channel cellular call from the recipient ... seeking access to the

Page 8

10/667,537 Heck 4-1/LUC-424

multimedia message awaiting delivery” as per claim 7. Therefore, claim 7 is not rendered obvious based on the applied references.

Independent apparatus claim 10 is believed to be allowable for reasons similar to those explained above with regard to claim 7.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

As explained above, Berger requires an MMS capable handset or its equivalent in order to control and interact with the UM server. To the extent that the examiner is suggesting that the use of a conventional voice-channel cellular call from a non-MMS capable handset could be utilized in Berger to control the UM server, this would constitute a substantial change of principle of operation of the system described in Berger. Hence, in accordance with the legal requirement of *In re Ratti*, such a modification of teachings is not permitted and hence would not render the subject matter of the present invention prima facie obvious.

Page 9

10/667,537 Heck 4-1/LUC-424

In view of the above, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Charles L. Warren", is written over a horizontal line.

Charles L. Warren
Attorney for Applicants
Reg. No. 27,407

Dated: December 28, 2005

CARMEN B. PATTI AND ASSOCIATES, LLC
Customer Number 47382